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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEAN E. ASCHEN, JAMES R. DORAN,
BRIAN P. OLORE, and JOSEPH RUDMANN

Appeal 2009-006069
Application 10/604,000
Technology Center 2100

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The Appellants describe the invention at issue on appeal as follows. "Access to data in a file created by a mail and calendaring client application is provided to other applications without the need for use of the mail and calendaring client." (Abstract.)

ILLUSTRATIVE CLAIM

> 10. A system for providing data stored in a mailfile to an application, comprising:
>
> a mailfile stored on a server, having data stored as documents with sections;
>
> a database for passing a request from an application running on a user workstation, for one of said documents to said mailfile and upon return of said one of said documents, converting said one of said documents into an extended markup format;
>
> an authentication directory having authentication records for an application; and
>
> mail and calendaring web service software running on a server different from said workstation, for receiving said request from said application for a document, receiving text files in an extended markup format from said database,

accessing binary data from said mailfile, creating an object comprising the converted document with said binary data inserted, authenticating said application using said directory, and sending said object to said application.

REJECTIONS

Claims 10-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Pub. No. 2002/0091782 A1 ("Benninghoff").

Claims 1-4 and 6-20 stand rejected under § 103(a) as being unpatentable over Benninghoff in view of U.S. Patent No. 5,913,033 ("Grout").

Claim 5 stands rejected under § 103(a) as being unpatentable over Benninghoff in view of Grout and further in view of U.S. Patent Application Pub. No. 2005/0114671 ("Little").[2]

CLAIM GROUPING

Based on the Appellants' arguments, we will decide the appeal of claims 10-15 on the basis of claim 10 alone. Likewise, will decide the appeal of claims 1-9 and 16-20 on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

[2] The Appellants failed to accurately state the rejection of claim 5. (Appeal Br. 4.)

ISSUE

The *issue* before us is whether the Examiner erred in finding that Benninghoff provides a mailfile of documents with sections as required by independent claims 1 and 10.

FINDINGS OF FACT

Benninghoff describes its invention as "a method and apparatus that provides a sender of email a unique and novel independent service to prove that the message and documents attached to the email, if any, were transmitted and received by the intended recipient, and to provide a duplicate thereof upon query . . . ." (¶ 0003.)

Grout describes its invention as follows.

> [A] document manager runs at a client computer and retrieves documents downloaded from a server computer across a communications medium. The documents can contain embedded links to objects, which are building blocks that make up or are associated with the documents. The client computer keeps a local copy of a standard-set of objects, so that when the client computer needs to present the linked objects to the user, the linked objects that are part of the standard set do not need to be retrieved from the server by the client.

(Col. 3, ll. 13-23.)

ANALYSIS

"Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc) (citations omitted). Here, independent claim 10 recites in pertinent part "a mailfile . . . having data stored as documents with sections."

Similarly, independent claim 1 recites "a mailfile . . . of documents having a section . . . ."

The Specification includes the following disclosure.

> A section is defined as additional data which may be hidden or visible when the document is viewed. For example, the document may have a subtitle, category, or other term with an expansion button nearby. A triangle shaped "twistee" button or any other type of expansion control may be used. When the expansion control is activated, such as by clicking a mouse pointer on a twistee, the additional data is either exposed or hidden from view.

(Spec. 5.)

Reading the independent claims in view of the Specification, we construe the claims as requiring a section that is capable of being hidden and capable of being visible, such that the section is either hidden or visible at any particular time.

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citations omitted).

Here, the Examiner makes the following findings.

> Benninghoff clearly discloses or suggests [] a mailfile stored on a server (Figure 1 elements 10 and 20: electronic package to be stored on a server), having data stored as documents having sections (Figure 3: electronic package comprising fields, text

and messages (body of text could be a section), paragraph 134).

. . .

(Ans. 9.) Figure 3 of Benninghoff follows.

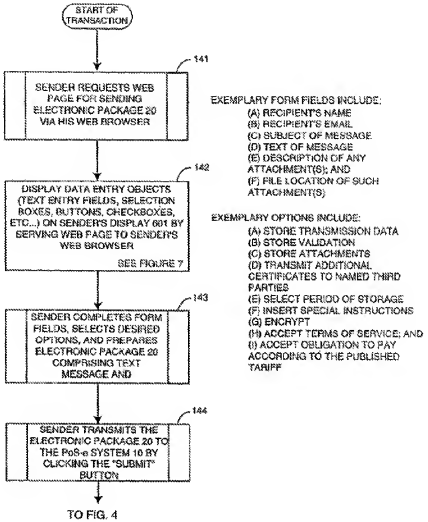

FIGURE 3

Figure 3 shows "preferred details associated with receiving the Electronic Package . . . ." (¶ 0093.) Benninghoff discloses the processing of the Electronic Package as follows.

> FIG. 5 shows the details associated with step 160 of FIG. 2, i.e. the delivery of the Electronic Package 20 to the Recipient 700. The Recipient 700 is hypothetically named Rhonda Recipient. At step 161, through her desktop, wireless, or other system 701 which is internet addressable, the Recipient 700 requests the web page that is identified by the hyperlink in the email notification 122 (see FIG. 9). Ideally, the Recipient simply follows the HTML link in the email notification 122, after which she simply enters her email. In case the Recipient's email client does not provide HTML services, an ALT function will describe the URL at which the Electronic Package 20 may be retrieved. The email notification 122 also contains, in addition to the URL, a message code or password generated for this particular transaction by Server 100. Using her email address and the password at the URL designated, the Recipient 700 may download the contents of the Electronic Package 20 that was prepared and transmitted by the Subscriber at step 143 and 144 of FIG. 3. At step 162, after the server sends the Recipient's client application the web page shown in FIG. 10, the Recipient enters her email address (e.g. "rhonda@recipient.com") and, if necessary, the message code (if the Recipient clicked on the hyperlink that includes the message code in the HTML request, the Recipient will only be asked to enter her email address). At step 163, the Server 100 verifies the Recipient's authority to take delivery of the Electronic Package by comparing her email address and provided message code with corresponding data in the Transaction Log 300. The Server 100 then presents the Recipient 700 with a download page like that shown in FIG. 11. At step 164, if she chooses to continue, the Recipient 700 elects to take delivery of the Electronic Package by either downloading it with a Java applet, by downloading it directly, or by receiving it as an encrypted email attachment. The Java applet results in a standard eml file on the Recipient's system. If

> Recipient chooses on the other options, however, the file is encrypted before being transmitted to the Recipient and she must obtain a password from the Server 100 in order to access the eml file within the encrypted file. At step 165, the Server delivers the Electronic Package 20 to the Recipient according to her chosen means of delivery. At step 166, the Server logs the delivery particulars to the Transaction Log 300.

(¶ 0134.)

We agree, however, with the Appellants that "there is no mention of anything related to sections . . . in the cited portions of Benninghoff." (Appeal Br. 6.) More specifically, the Examiner's references to Figure 3 and ¶ 0134 fail to show that this body of text can be either hidden or visible. Furthermore, the Examiner does not allege, let alone show, that the addition of Grout or Little cures the aforementioned deficiency of Benninghoff. Based on the aforementioned facts and analysis, we *conclude* that the Examiner has erred in finding that Benninghoff provides a mailfile of data stored as documents with sections as required by independent claims 1 and 10.

DECISION

We reverse the rejections of claims 1 and 10 and those of claims 2-9 and 16-20 which depend therefrom.

REVERSED

Tkl

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